

<b>Notice of Allowability</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/759,493	URBAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Andrea M. Valenti	3643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 15 December 2005.
2. ☒ The allowed claim(s) is/are 22 and 24-43.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All    b) ☐ Some\*    c) ☐ None    of the:
  1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  5. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

#### Attachment(s)

- |   |   |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892)  | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                       |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),<br>Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment                               |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material          | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance              |
|   | 9. <input checked="" type="checkbox"/> Other <u>Election/Restriction</u> .                        |

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-21, drawn to a structural cell system, classified in class 405, subclass 258.1.
- II. Claims 22-43, drawn to a multilayered structural cell system with water storage, classified in class 47, subclass 48.5.
- III. Claims 44-46, drawn to method of making an urban tree growing system, classified in class 47, subclass 32.8.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the subcombination as claimed has three layers of structural cells and the combination as claimed requires only one layer of structural cells. The subcombination has separate utility such as a water storage device.

Inventions III and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process

Art Unit: 3643

(MPEP § 806.05(f)). In the instant case, the process as claimed can be used to make another materially different product namely a structural cell system without a water egress from the plurality of structural cells.

Inventions III and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the process as claimed can be used to make another materially different product namely a structural cell system without a water egress from the plurality of structural cells.

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

During a telephone conversation with Jon Ikegami on 27 February 2006 a provisional election was made without traverse to prosecute the invention of Group II, claims 22-43. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-21 and 44-46 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### **EXAMINER'S AMENDMENT**

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Jon Ikegami on 27 February 2006.

The application has been amended as follows:

**Claims 1-21 were cancelled**

**Claim 22, line 4**, "a first layer of structural cells for short-term water storage configured for positioning below the hardscape, the first layer of structural cells being capable of short term water storage;" was changed to --a first layer of structural cells positionable below the hardscape, the first layer of structural cells are short term water storage cells;--

**Claim 22, line 8**, "a second layer of structural cells configured for positioning below the first layer," was changed to --a second layer of structural cells positioned below the first layer,--

**Claim 22, line 11**, "cells;" was changed to --cells; wherein tree-roots penetrate the second layer through openings in the structural cells sized to accept the tree roots from a tree external to the structural cells;--

**Claim 22, line 12**, "a third layer of structural cells configured for positioning below the second layer, the third layer of structural cells configured for long-term water storage;" was changed to --a third layer of structural cells positioned below the second layer, the third layer of structural cells are long term water storage cells;--

**Claim 23 was cancelled**

**Claims 44-46 were cancelled**

***Allowable Subject Matter***

Claims 22 and 24-43 are allowed.

The following is an examiner's statement of reasons for allowance:

Cited references U.S. Patent No. 6,779,946; U.S. Patent Pub. No. US 2004/0076473; U.S. Patent No. 6,277,274; U.S. Patent No. US 2003/0082359; U.S. Patent No. 5,810,510; U.S. Patent No. 5,383,302; U.S. Patent No. 6,237,283; U.S. Patent No. 5,322,629; U.S. Patent Pub. No. US 2002/0170509; U.S. Patent No. 5,460,867; U.S. Patent No. 6,540,436; U.S. Patent No. 4,771,572; U.S. Patent No. 6,095,718; U.S. Patent No. 6,569,321; U.S. Patent Pub. No. US 2001/0045383; U.S. Patent No. 6,428,870; Japanese Patent JP 02161008; Japanese Patent JP 04099411 teach positionable under hardscape layered cell structures with water storage, water ingress, and water egress for filtering, retention, storage and infiltration of storm water and structural cells at ground level filled with soil and planted with plants such as grass.

The prior art of record all fails to show, and fails to make obvious, either alone and or in combination a first layer of structural cells that are short term water storage

Art Unit: 3643

cells; a second layer of structural cells below the first layer including a tree-rooting medium supporting the normal growth of structural roots within the second layer and wherein tree-roots penetrate the second layer through openings in the structural cells sized to accept the tree roots from a tree *external* to the structural cells; and a third layer of structural cells that are long term water storage cells; permeable barriers between the first and second layers and second and third layers, and finally water ingress into the first layer and water egress from the third layer.

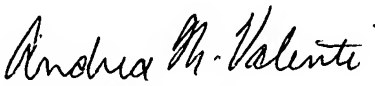
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea M. Valenti whose telephone number is 571-272-6895. The examiner can normally be reached on 7:00am-5:30pm M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on 571-272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3643

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Andrea M. Valenti  
Patent Examiner  
Art Unit 3643

27 February 2006